

Attorney Docket No.: P-408 (TI-0013)  
Inventors: Taylor et al.  
Serial No.: 09/802,466  
Filing Date: March 9, 2001  
Page 9

#### REMARKS

Claims 1-33 are pending in this application. Claims 1-6, 11, 12, 21, 23, 26, 27, and 30-33 have been rejected. Claims 5, 7-10, 12-20, 22-25, 28, 29, and 32 have been objected to. The Examiner has acknowledged that claims 7-10 and 28 are drawn to allowable subject matter, if rewritten in independent form to include all of the limitations of the base claim and any intervening claims. Claims 5, 7, 26, 28, and 32 have been amended. Claims 3, 12-20, 22-25 and 29 have been canceled. No new matter has been added by these amendments. Reconsideration is respectfully requested in light of the following remarks and amendments.

#### **I. Elections/Restrictions**

Claims 13-19, 20, 22, 24, 25 and 29 are withdrawn from consideration as being drawn to a nonelected species. Accordingly, Applicants are hereby canceling claims 12-20, 22-25 and 29 from this case. Applicants retain the right to pursue any or all of this canceled subject matter in a continuing application at a later time.

Attorney Docket No.: P-408 (TI-0013)  
Inventors: Taylor et al.  
Serial No.: 09/802,466  
Filing Date: March 9, 2001  
Page 10

## **II. Information Disclosure Statement**

The Information Disclosure Statement is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. The Examiner suggests that Applicant is required to delete the embedded hyperlink and/or other form of browser executable code as the information in the IDS is printed on the face of the file, the embedded hyperlink and or other browser executable codes must be deleted. The Information Disclosure Statement is suggested to contain three patent applications by others the application have been considered but have been crossed through on the IDS and will not be published on the face of the file because there is a valid reason why the office could not want certain pending applications to be listed as prior art on the face of the patent.

Applicants are submitting herewith a substitute IDS which has deleted the embedded hyperlinks.

## **III. Specification**

The disclosure is objected to because of the following informalities: on page 23 line 24, Figure 14 appears to be mistakenly referred to as Figure 4. Acetonitrile on page 30 line 25 is misspelled.

Attorney Docket No.: **P-408 (TI-0013)**  
Inventors: **Taylor et al.**  
Serial No.: **09/802,466**  
Filing Date: **March 9, 2001**  
Page 11

Applicants have amended page 23, line 24, Figure 4 to read Figure 14. Support for this amendment is found throughout the specification and at page 23. No new matter has been added.

Further, Applicants have amended page 30, line 25 to correct a typographical error. Support for this amendment is found throughout the specification and at page 30. No new matter has been added.

#### **IV. Claim Objections**

Claim 5 is objected to because of the following informalities:

MIPC is abbreviated, the Examiner suggests that the term should be spelled out completely for clarity. In accordance with the Examiner's suggestion claims 5 and 26 have been amended to delete MIPC and replace the term with -- Matched Ion Polynucleotide Chromatography--. Support for this amendment is found throughout the specification and at page 1, line 12. No new matter has been added.

Claim 32 is objected to because a space is required between "inhibitors" and "and". In accordance with the Examiner's suggestion claim 32 has been amended to insert a space between the terms "inhibitors" and "and". No new matter has been added.

Attorney Docket No.: **P-408 (TI-0013)**  
Inventors: **Taylor et al.**  
Serial No.: **09/802,466**  
Filing Date: **March 9, 2001**  
Page 12

Withdrawal of this objection is respectfully requested.

**V. Rejections under 35 U.S.C. 102**

**A. Relating to Gjerde WO 98/56798.**

Claims 1-6, 11, 12, 21, 23, 26, 27, 30-33 are rejected under 35 U.S.C. 102(e) as anticipated by Gjerde WO 98/56798. Gjerde is suggested to teach separation of polynucleotides by MIPC wherein multivalent cations are removed from all aspects. The separation media is suggested to be silica and support non-polar organic polymers or long chain C1 to C24 hydrocarbon groups bound to inorganic substrates, and to have an average diameter of 1-100 microns. It is suggested that the present invention can be used in the separation of RNA although for purposes of description, DNA is described and the procedure can be used for batch process. The procedure disclosed by Gjerde et al. is suggested to be the same as that recited in the instant invention and to yield RNA that is substantially free of agents capable of catalyzing degrading of RNA. Applicants respectfully traverse this rejection.

As recited in MPEP §706.02, in order to apply a reference as prior art under 35 U.S.C. §102(e), the inventive entity of the application must be different than that of the reference. MPEP

Attorney Docket No.: P-408 (TI-0013)  
Inventors: Taylor et al.  
Serial No.: 09/802,466  
Filing Date: March 9, 2001  
Page 13

\$715.01(b) recites "[w]here however, a rejection is applied under 35 U.S.C. 102(f)/103 or 35 U.S.C. 102(g)/103, or in an application filed on or after November 29, 1999, under 35 U.S.C. 102(e)/103 using the reference, a showing that the invention was commonly owned, or subject to an obligation of assignment to the same person at the time the later invention was made would preclude such a rejection or be sufficient to overcome such a rejection.

The present application and WO 98/56798 are both assigned to the same entity namely Transgenomic, Inc. These patents therefore cannot be considered to be the work of another, but of the same entity. Accordingly, this obligation of assignment precludes a rejection under 35 U.S.C. §102(e).

Withdrawal of this rejection is respectfully requested.

**B. Gjerde - US Patent 5,972,222**

Claims 1-6, 11, 12, 21, 23, 26, 27, 30-33 are rejected under 102(e) and 102(a) as being anticipated by Gjerde (US Patent 5,972,222). Gjerde teach separation of polynucleotides by MIPC multivalent cations are removed from all aspects. It is suggested that the separation media can be silica and support non-polar organic polymers or long chain C1 to C24 hydrocarbon groups bound to inorganic substrate with an average diameter of 1-100 microns.

Attorney Docket No.: **P-408 (TI-0013)**  
Inventors: **Taylor et al.**  
Serial No.: **09/802,466**  
Filing Date: **March 9, 2001**  
Page 14

It is suggested that the present invention can be used in the separation of RNA although for purposes of description, DNA is described and the procedure can be used for batch processes. The procedure disclosed by Gjerde is suggested to be the same as that recited by the instant invention, and to yield RNA that is substantially free of agents capable of catalyzing degradation of RNA. Applicants respectfully traverse this rejection.

In accordance with MPEP 706.02 as set forth above, the present application and U.S. Patent 5,972,222 are both assigned to the same entity, namely, Transgenomic Inc. These patents therefore cannot be considered to be the work of another, but of the same entity. Accordingly, this assignment precludes rejection under 35 U.S.C. 102(e) and 102(a).

Withdrawal of this rejection is respectfully requested.

**C. U.S. Patent 5,986,085.**

Claims 1-6, 11, 12, 21, 23, 26, 27, 30-33 are rejected under 35 U.S.C. 102(a) and (e) as being anticipated by Gjerde et al. US 5,986,085. Gjerde is suggested to teach a batch process for obtaining polynucleotides from a mixture of polynucleotide fragments such as RNA. The present invention is suggested to be used in the separation of RNA although for purposes of description, DNA is described and the procedure can be used for

Attorney Docket No.: **P-408 (TI-0013)**  
Inventors: **Taylor et al.**  
Serial No.: **09/802,466**  
Filing Date: **March 9, 2001**  
Page 15

batch process. The procedure disclosed by Gjerde is suggested to be the same as that recited in the instant invention. It is further suggested that it would be expected to yield RNA that is substantially free of agents capable of catalyzing degradation of RNA. Applicants respectfully traverse this rejection.

The present invention and U.S. Patent 5,986,085 are both assigned to the same entity, namely, Transgenomic Inc. These patents therefore cannot be considered to be the work of another, but of the same entity. Accordingly, this obligation of assignment precludes rejection under 35 U.S.C. 102(e) and 102(a).

Withdrawal of this rejection is respectfully requested.

#### **VI. Rejection under 35 U.S.C. 112**

Claim 3 has been rejected under 35 U.S.C. 112 second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 3 recites the limitation "the nuclease" in 2. In an effort to facilitate prosecution of this case, claim 3 has been canceled.

Withdrawal of this rejection is respectfully requested.

Attorney Docket No.: P-408 (TI-0013)  
Inventors: Taylor et al.  
Serial No.: 09/802,466  
Filing Date: March 9, 2001  
Page 16

#### **VII. Allowable Subject Matter**

Claims 7-10, and 28 have been objected to as being dependent on a rejected base claim, but have been acknowledged to be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

In accordance with the Examiner's suggestion, Applicants have amended claims 7-10 and 28 so that they are presented in independent form including all of the limitations of the base claim and any intervening claims. Applicants respectfully request withdrawal of this objection and subsequent allowance of these claims.

#### **VIII. Conclusion**

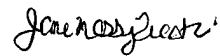
Applicants believe that the foregoing comprises a full and complete response to the Office Action of record. Accordingly,



Attorney Docket No.: P-408 (TI-0013)  
Inventors: Taylor et al.  
Serial No.: 09/802,466  
Filing Date: March 9, 2001  
Page 17

favorable reconsideration and subsequent allowance of the pending claims is earnestly solicited.

Respectfully submitted,



Jane Massey Licata  
Registration No.

Date: November 3, 2003

LICATA & TYRRELL PC  
66 E. Main Street  
Marlton, New Jersey 08053

(856) 810-1515